

Application No. 10/715,566

**REMARKS**

Claims 1-8 and 10-16 are pending. By this Amendment, claims 1 and 10 are amended, claim 9 is canceled, and claim 16 is added. Claim 1 is amended to include the subject matter of original claim 9 and merely provides that which was present in claim 9 when the claims were initially submitted.

In the Office Action, the following prior art rejections are made:

- (1) Claims 1-8, 10, 11, 14, and 15 are rejected under 35 U.S.C. §103(a) as being unpatentable over WO 90/10112 to O'Connor (O'Connor) in view of U.S. Patent 4,695,493 to Friedlander et al. (Friedlander) and U.S. Patent 6,426,129 to Kalwara et al. (Kalwara).
- (2) Claim 9 is rejected under 35 U.S.C. §103(a) as being unpatentable over O'Connor in view of Friedlander and Kalwara as applied to claim 1, and further in view of U.S. Patent 3,893,252 to Chase.
- (3) Claim 12 is rejected under 35 U.S.C. §103(a) as being unpatentable over O'Connor in view of Friedlander and Kalwara as applied to claim 11, and further in view of U.S. Patent 4,849,267 to Ward et al. (Ward).
- (4) Claim 13 is rejected under 35 U.S.C. §103(a) as being unpatentable over O'Connor in view of Friedlander and Kalwara as applied to claim 11, and further in view of U.S. Patent 6,517,922 to Ang et al.

As claim 1 is amended to include the features of original claim 9, the first rejection is moot, and the second rejection will be addressed.

The Office Action asserts that O'Connor discloses a method of applying carpet strips to deck planking and that it would have been obvious to provide moldable adhesive covered by a release sheet in view of Friedlander's peel and stick three dimensional carpet pieces that

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are contoured to fit automotive components prior to installation. As discussed in col. 7, lines 8-26, in Friedlander, flat sections of the assembly of a predetermined size are cut and the cut sections are cold-pressed into a predetermined three-dimensional contour and packaged for shipment. At an automobile assembly plant, the release liners are removed from the three dimensional products and applied to contoured automobile panels.

The Office Action acknowledges that Friedlander does not suggest of a release sheet with a separable positioning strip. Kalwara is cited to meet this deficiency as it shows a release sheet 20 for a rubber roofing membrane that is scored, perforated or split at 22. During installation of the roofing membrane, one portion of the release liner is removed by flexing the adhesive rubber article and peeling that portion of the release liner from the score 22 outwardly to the edge. The score 22 creates a mark 30 in the adhesive that allows the installer to view the mark 30 as the article is unrolled over the substrate to align and place the rubber sheet over the substrate as desired.

The Office Action asserts that it would have been obvious to provide a separable positioning strip to tack a portion of O'Connor's carpet, as modified by the teachings of Friedlander's shaped panel, and to remove the remaining release sheet to adhere the entire width of the carpet as disclosed by Kalwara's roofing membrane for properly aligning the material on a substrate.

The initial asserted combination of O'Connor as modified by Friedlander, which is then modified by Kalwara is not plausible. The method of Kalwara requires that the sheet be flexed in order to pull half of the release sheet free. Friedlander's carpet component is precontoured and therefore cannot be flexed during installation. Thus, there would be no motivation to make the asserted modification to Friedlander's release sheet in view of Kalwara. In fact, such a modification would destroy the functionality of Friedlander's invention.

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Chase is added to the rejection as teaching of a method of mounting photos including, according to the Office Action, using sectioned release sheets with a strip at a central portion, removing the strip, depressing the central portion of the mount on the substrate to tack the central portion, which allows for adjustment and repositioning, removing the remaining release sheet sections, and bonding the mount to the substrate (citing col. 6, lines 34-68.) However, Chase does not describe this method. In Chase,

“[t]he picture P with its mount secured thereto is placed on the album page support 1 after the center portion CA of the adhesive A has been uncovered by removal of release sheet section CR from the back of the mount, but the exposed or uncovered adhesive CA does not contact the support 1, as shown in phantom outline in FIG. 10 due to the stiffness of the picture and mount, the thickness of the remaining release sheet sections, and the relatively narrow width between the adjacent remaining release sheet sections IR and IR. The picture and mount are then moved to the proper location and depressed in the central portion until the central portion CA of the adhesive contacts the support 1 and fixes the picture and mount in final position.” (Col. 6, lines 38-52.)

Thus, the photo is positioned in its final position before the central portion is adhered. The central portion is only adhered when placement is final. The central portion is not used as a positioning mechanism; it is used to smoothly mount the entire area of the picture without bubbles or wrinkles. (See, col. 6, lines 31-33, for example.) This is also emphasized in col. 6, lines 4-19:

“When a picture is to be secured to the mount of FIGS. 1 to 3, the mount preferably is placed on a horizontal surface such as a table top and the central release sheet section CR is removed from one side of the mount as in FIG. 1 and the picture P is placed on the mount contacting only the remainder of the release sheet sections IR, IR, ER, ER so the picture can be moved about freely without contacting the exposed adhesive CS, as illustrated by the dash-dot line in FIG. 3. After the picture is accurately located and aligned in relation to the mount and the guide lines G, the user presses his fingers F against the portion of the picture overlying the exposed adhesive CA and presses that

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portion of the picture into adhering contact with the adhesive A as in FIG. 3, thereby retaining the picture in accurate location.”

Thus, Chase does not provide a teaching of the claimed method and therefore does not remedy the deficiencies of the asserted combination of O'Connor, Friedlander, and Kalwara.

Further, no one of ordinary skill in the floor covering art would look to photo mounting to teach of a method of applying a covering to a board for exterior use using a flexible elongated strip of covering material. In laying floor covering outdoors, the environment, the materials, the quality of the materials, and the handling considerations are entirely different than in photo mounting. The combination is improper for at least these reasons.

The combination recited in claim 1 is not disclosed or even suggested by the asserted rejection in the Office Action. Thus, claim 1 is allowable.

As for the rejection of claim 12, the Office Action cites Ward as showing a release sheet with arrows marking the direction of pile. However, Ward's arrows 40 are formed on the backing 14 rather than the release sheet. There is no suggestion for printing the arrows on the release sheet, which will be discarded. Additionally, Ward does not remedy the deficiencies of the combination of references discussed above. Ward does not render claim 12 obvious. Claim 12 is allowable.

As for the rejection of claim 13, the Office Action cites Ang as disclosing visual indicia. Colored thread 52 is provided between ribbon 40 and tape 42 to assist the user in aligning the edging strip 38 in the correct position. The colored thread neither discloses nor even suggests of providing measuring marks as claimed. Additionally, Ang does not remedy the deficiencies of the combination of references discussed above. Ang does not render claim 13 obvious. Claim 13 is allowable.

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New claim 16 recites that the release sheet is provided as three pieces across the width of the elongated strip of covering material, including two side pieces and a middle piece that forms the positioning guide strip. Support for this claim is found throughout the disclosure, see Fig. 5 and paragraph [0052] for example. As none of the prior art references discloses or suggests of this combination, claim 16 is patentable.

It is respectfully submitted that the claims are allowable and that the application is in condition for allowance. A prompt notice to that effect is respectfully requested. Should further issues require resolution prior to allowance, the Examiner is requested to telephone the undersigned.

Respectfully submitted,



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